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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,671	04/04/2001	Hiroaki Mashiko	N02-129931C/KK	1905

21254 7590 01/29/2003

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EXAMINER

GREENE, JASON M

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 01/29/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/824,671

Applicant(s)

MASHIKO ET AL.

Examiner

Jason M. Greene

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-22.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

1. The period for reply continues to run 3 MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

2. The amendment filed 10 January 2003 under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

Allowed claim(s): None

Rejected claim(s): 1-22

Claim(s) objected to: None

Response to Amendment

Response to Arguments

3. Applicant's arguments filed 10 January 2003 have been fully considered but they are not persuasive.

In response to Applicants' argument that the EP 0 811 479 A2 reference is directed to a battery separator and not to a filter, the Examiner recognizes that the laminated structure of EP 0 811 479 A2 is disclosed as preferably being for use as a battery separator. See abstract at lines 1-2. However, the Examiner notes that EP 0 811 479 A2 explicitly teaches similar structures being used as filters in page 1, lines 7-8. Therefore, while the laminated structure of EP 0 811 479 A2 is preferably for use as a battery separator, one of ordinary skill in the art at the time the invention was made would have recognized that the laminated structure could also have been used as a filter.

In response to applicant's argument that there is no suggestion to combine the EP 0 811 479 A2 reference and the Tyvek® publication, the Examiner contends that the material used to form the substrate layer of the filter of EP 0 811 479 A2 is the exact same material as one of the styles of TYVEK® taught in the TYVEK® publication and that, therefore, the Tyvek® publication is relied upon only to provide the physical properties of the substrate layer of the filter of EP 0 811 479 A2. Therefore, the Examiner contends that there need not be a suggestion to combine the references since the material disclosed in the TYVEK® publication is the exact same material as

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the material used to form the substrate layer of the filter of EP 0 811 479 A2. Combining the references would merely reproduce the structure already disclosed by EP 0 811 479 A2.

EP 0 811 479 A2 discloses the substrate layer being formed of a TYVEK® material having a thickness of 100 μm (4 mills) and a basis weight of 41 g/m^2 (1.2 ox/yd^2) in col. 11, lines 46-54. Comparing the thickness and basis weight of the TYVEK® material disclosed in EP 0 811 479 A2 to the properties of the available styles of TYVEK® disclosed in the TYVEK® publication, it is apparent that the substrate layer of the filter taught in EP 0 811 479 A2 is either TYVEK® 1422A or 1422R. Therefore, the substrate of EP 0 811 479 A2 is seen as inherently being formed from either TYVEK® 1422A or 1422R.

In response to Applicants' argument that EP 0 811 479 A2 does not teach the filter having a Gurley number less than 100 sec/100 ml, the Examiner recognizes that EP 0 811 479 discloses the filter having a Gurley number between 100 sec/100 ml and 1000 sec/100 ml. However, the Examiner contends that it would have been obvious to extend the range of EP 0 811 479 A2 downward in that one of ordinary skill in the art at the time the invention was made would have expected a filter having a Gurley number slightly less than 100 to exhibit roughly the same properties as a filter having a Gurley number of 100 sec / 100 ml. For example, a filter having a Gurley number of 99.999 sec / 100 ml reads on a filter having a Gurley number of less than 100 sec / 100 ml. One of ordinary skill in the art at the time the invention was made would have expected the filter

having a Gurley number of 99.999 sec / 100 ml to exhibit roughly the same properties as a filter having a Gurley number of 100 sec / 100 ml since the difference between the two filters would be only a slight difference in permeability. Additionally, Applicants' have not provided any evidence to establish the criticality of the Gurley number being less than 100 sec / 100 ml. In fact, the Examiner notes that the Applicants disclose the Gurley number of the filter being 100 sec / 100 ml and 300 sec / 100 ml in page 5, lines 12-18 of the Specification.

In response to applicant's argument that the Scarmoutzos and Shen references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, EP 0 811 479 A2 is directed to a filter and Scarmoutzos and Shen are directed to rendering a filter water-repellant and oil repellent. As noted above, while the structure of EP 0 811 479 A2 is disclosed as preferably being used as a battery separator, EP 0 811 479 A2 does teach the structure being for use as a filter.

In response to applicant's argument that EP 0 630 755 A2 and JP 9-295406 are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem

with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, EP 0 630 755 A2 and JP 9-295406 each disclose an ink cartridge having an air vent covered by a laminated air permeable filter. European Patent Application EP 0 811 479 A2 is seen as being analogous art since both Applicants and EP 0 811 479 A2 are concerned with providing an air-permeable, and liquid excluding filter that is capable of being incorporated into an ink cartridge

In response to applicant's argument that there is no suggestion to combine the EP 0 811 479 A2 and EP 0 630 755 A2 or JP 9-295406 references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art at the time the invention was made would have recognized that the air-permeable filters of EP 0 811 479 A2 and the internet publication "Tyvek® for Packaging - Products" could be incorporated into the ink cartridge of EP 0 630 755 A2 or JP 9-295406 to provide a vent filter for the ink cartridge having good mechanical rigidity to prevent the filters from being damaged in transit to prevent ink from being lost from the cartridge. While EP 0 811 479 A2 is disclosed as having a specific utility as a battery separator membrane,

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EP 0 811 479 A2 explicitly teaches that similar separators can be used as various types of filters in page 1, lines 7-8. Therefore, since EP 0 630 755 A2 and JP 9-295406 each disclose an ink cartridge having an air vent covered by a laminated air permeable filter, one of ordinary skill in the art at the time the invention was made would have recognized that the high mechanical strength filter of EP 0 811 479 A2 could have been substituted for the lower mechanical strength filters of EP 0 630 755 A2 and JP 9-295406.

In response to applicant's argument that the JP 7-171318 reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, JP 7-171318 discloses forming the substrate layer of a laminated filter from ultrahigh molecular weight polyethylene. European Patent Application EP 0 811 479 discloses forming a filter having a substrate formed of TYVEK®. Therefore, JP 7-171318 is seen as being analogous art since both Applicants' and JP 7-171318 are concerned with forming a filter substrate from ultrahigh molecular weight polyethylene.

In response to applicant's argument that the Miksch reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's

endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Miksch discloses a filter wherein the porous layer is laminated on each side of the substrate. European Patent Application EP 0 811 479 discloses forming a filter having a porous layer on one side of the substrate. Therefore, Miksch is seen as being analogous art since both Applicants' and Miksch are concerned with forming a filter having a porous layer laminated on each side of the substrate.

4. See 37 CFR 1.193(a)(2) which provides for the inclusion of the proposed rejection(s) detailed below in the Examiner's Answer if applicant elects to file an appeal to the Board of Patent Appeals and Interferences in this proceeding. To be complete, such rejection(s) must be addressed in any brief on appeal.

5. Upon appeal and entry of the amendment:

Claims 1, 2, 6-13, 17, and 19 would be rejected for the reasons set forth in **paragraph 7** of the final Office Action mailed 11 October 2002.

Claim 3 would be rejected for the reasons set forth in **paragraph 8** of the final Office Action mailed 11 October 2002.

Claims 5 and 16 would be rejected for the reasons set forth in **paragraph 9** of the final Office Action mailed 11 October 2002.

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Claims 4, 14, 15, and 18 would be rejected for the reasons set forth in **paragraph 10** of the final Office Action mailed 11 October 2002.

Claim 20 would be rejected for the reasons set forth in **paragraph 11** of the final Office Action mailed 11 October 2002.

Claim 21 would be rejected for the reasons set forth in **paragraph 12** of the final Office Action mailed 11 October 2002.

Claim 22 would be rejected for the reasons set forth in **paragraph 12** of the final Office Action mailed 11 October 2002.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (703) 308-6240. The examiner can normally be reached on Tuesday - Friday (7:00 AM to 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Simmons can be reached on (703) 308-1972. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jason M. Greene
Examiner
Art Unit 1724



jmg
January 24, 2003



David A. Simmons
Supervisory Patent Examiner
Technology Center 1700